

Application No. 09/994,492
Response dated April 23, 2004
Reply to Office Action of March 4, 2004

REMARKS

Claims 1-6, 8-14, 16-18, 21-23, 25-27, and 30-35 are pending in the application. The Examiner rejected Claims 14, 16-18, 21-23, 25-27, 30 and 33-35 and objected to Claims 31 and 32. Claims 1-6 and 8-13 are allowed.

Claim Rejections – 35 U.S.C. §112

Applicant has amended Claim 14 to obviate the Examiner's 35 U.S.C. §112, second paragraph rejection thereof.

Claim Rejections – 35 U.S.C. §103

Claims 14, 16-18, 21-23, 25-27, 30, and 33-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rubin '057 (U.S. Patent No. 3,716,057) in view of Mikhail '349 (U.S. Patent No. 5,308,349). The Examiner cited Rubin '057 as disclosing cutter 14 with spacer 16, handle 10, and head 12. The Examiner indicated that Rubin '057 did not teach an extension that tapers from the handle and a head having a radius of curvature whereby the head can be positioned intermediate a ball and socket of a ball and socket joint. The Examiner then referred to Mikhail '349 and indicated that this reference disclosed the use of a surgical instrument including an extension that tapers from the handle and a head having a radius of curvature whereby the head can be positioned intermediate the ball and socket of a ball and socket joint so that the device could fit within the intercondylar notch of the femur and be used as a fulcrum without damaging the femur during knee surgery. The Examiner concluded that it would have been obvious to one in ordinary skill in the art at the time the invention was made to modify the device of Rubin '057 as taught by Mikhail '349 so that the device could fit within the intercondylar notch of the femur and use that portion as a fulcrum without damaging the femur.

Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness based on Rubin '057 and Mikhail '349. Specifically, Applicant respectfully submits that the Examiner has not established a teaching, suggestion, or motivation to combine Rubin '057 with Mikhail '349.

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Mikhail '349 discloses a number of retractors useful in performing knee surgery as well as a method of utilizing the same. The retractors disclosed by Mikhail '349 all include blunt or rounded ends to protect, e.g., ligaments of the knee joint. See, U.S. Patent No. 5,308,349, column 4, line 32 ("The ends 43 are rounded"), column 5, lines 42-43 ("The end portions of each of the prongs 63 and 64 taper to rounded tips"), column 7, line 19 ("The end is rounded"), column 7, lines 43-44 ("A tip 103 extends from the integral support section 98 to a blunt free end 106."). Mikhail '349 further specifies that "[t]he unicompartamental retractor 140 is inserted around the side and posterior aspect of the tibial condyle, either the lateral tibial condyle 13 or medial tibial condyle 14, in order to protect the collateral ligament and posterior structures during unilateral proximal tibial osteotomy." U.S. Patent No. 5,308,349, column 10, lines 28-33 (Emphasis added).

Contrary to the objective of Mikhail '349 (i.e., to protect the structures of the knee), the device of Rubin '057 includes a sharp cutting edge at one end. Were such a sharp cutting edge provided with a retractor of Mikhail '349, the stated goal of Mikhail '349 (to lessen the risk of damage to structures of the knee including the ligaments thereof), would be impeded. Therefore, Applicant respectfully submits that a person of ordinary skill in the art would not be motivated to combine the disclosure of Mikhail '349 with the disclosure of Rubin '057, but rather would be lead away from such a combination. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of Claims 14, 16-18, 21-23, 25-27, 30, and 33-35.

Drawings

Responsive to the Examiner's objection to the drawings, Applicant respectfully directs the Examiner's attention to the ball and socket joint depicted in Figures 7-9.

Allowable Subject Matter

Applicant appreciates the Examiner's indication of allowable subject matter in Claims 31 and 32 and the Examiner's allowance of Claims 1-6 and 8-13. In view of the arguments advanced above, Applicant respectfully submits that all pending claims are in condition for allowance.

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Applicant appreciates the Examiner's courtesy during our telephone conversation of April 21, 2004. During this conversation, Applicant requested a telephone interview to discuss the Office Action of May 4, 2004. The Examiner indicated that it was not his practice to grant telephone interviews after issuing a final rejection. The Examiner did however indicate that if he did not agree that all pending claims were in condition for allowance after entry of the current Amendment and Request for Continued Examination, that he would telephone the undersigned attorney to schedule a telephone interview to discuss the pending rejections.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested. Specifically, Applicant respectfully submits that the current application is in condition for allowance and such action is earnestly solicited.

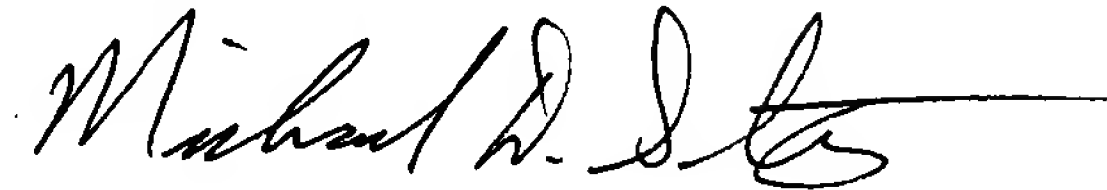
In the event Applicant has overlooked the need for an extension of time or payment of fee, Applicant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

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If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 219/424-8000.

Respectfully submitted,

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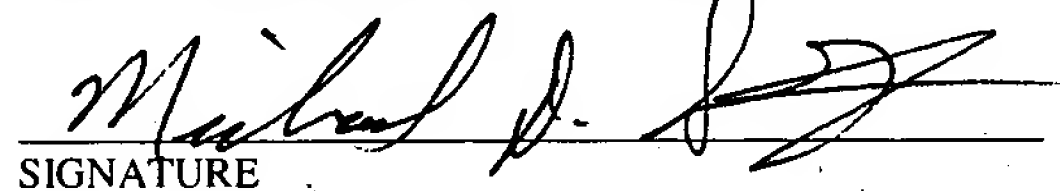
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SIGNATURE

April 23, 2004
DATE